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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,018	01/15/2002	William Kress Bodin	AUS920010853US1	5704

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EXAMINER	
LEZAK, ARRIENNE M	
ART UNIT	**PAPER NUMBER**
2143	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/047,018	BODIN ET AL.	
	Examiner	Art Unit	
	Arrienne M. Lezak	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-21 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Examiner notes that no claims have been amended, cancelled or added. Claims not explicitly addressed herein are found to be addressed within prior Office Action dated 6 October 2005 as reiterated herein below.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 4-8, 11-15 & 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over extensive consideration of US Patent 6,092,114 to Shaffer.

3. Regarding Claims 1, 8 & 15, Shaffer discloses a system, method and computer program for email administration comprising the steps of:

- receiving in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain, (Col. 2, lines 30-65 & Col. 6, lines 31-53);
- receiving in the transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification, (Col. 6, lines 6-67 & Col. 7, lines 1-38), (Examiner notes that Shaffer discloses a message sent by a

sender to the server where a determination is made based on client capabilities, wherein said message would obviously be a default means of requesting capability status, especially in light of the fact that Shaffer discloses a capability status determination, a conversion means, and a notification to sender means, all related to the ability of the client/target device to receive the sender's message, and wherein the sender is notified of a client's inability to receive the message based on conversion requirements, which requirements are obviously an indication of the client/domain ability/capability to receive the sender's message. Additionally, the motivation to request client capability is also found within Shaffer which teaches the need for files to be accessible to the client device as well as a conversion consideration, wherein both conversion time and data loss are important access file/sharing issues, (Col. 1, lines 55-67 & Col. 2, lines 1-27));

- finding, in dependence upon the domain identification, at least one email display capability status record for the domain, wherein the email display capability status record for the domain comprises at least one of the email display capability status attributes, (Col. 6, lines 6-67 & Col. 7, lines 1-38), (Examiner notes that Shaffer discloses wherein if an attachment does not need conversion, it is transmitted to the client/target. Moreover, Shaffer teaches a checking, determining and converting process, wherein the client does not intervene with the same, and wherein the client/target

email display capability status attributes are determinative of the need for sender notification and/or conversion); and

- sending at least one of the email display capability status attributes to the sender, (Col. 6, lines 6-67 & Col. 7, lines 1-38), (Examiner notes that Shaffer teaches sender notification concerning conversion requirements, which conversion requirement obviously represent client/target display capability status attributes).

Thus, Claims 1, 8 & 15 are found to be unpatentable over considerable consideration of the teachings of Shaffer.

4. Regarding Claims 4, 11 & 18, Shaffer is relied upon for those teachings noted herein. Shaffer further discloses:

- receiving an email in a transcoding gateway, the email comprising an email address and at least one digital object, (Claims 1-20);
- determining, in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway, wherein the determining results in a determination, (Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38);
- forwarding the email, including the digital object, to the email address, if the determination is that the digital object is not to be transcoded in the transcoding gateway, (Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38); and
- if the determination is that the digital object is to be transcoded in the transcoding gateway, carrying out the further steps of transcoding the

digital object into a transcoded digital object; and downloading the transcoded digital object to a destination client device, (Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38).

Thus, Claims 4, 11 & 18 are found to be unpatentable over considerable consideration of the teachings of Shaffer.

5. Regarding Claims 5, 12 & 19, Shaffer is relied upon for those teachings noted herein. Shaffer further discloses:

- transcoding the digital object further comprises transcoding the digital object into a digital file having a digital format and a file name, (Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38); and
- downloading the transcoded digital object further comprises downloading the digital file to a destination client device at an internet address recorded in an Internet address field of a client device record, the client device record having recorded in a mailbox address field in the client device record, a mailbox address identical to the email address of the email message, (Col. 2, lines 30-67; Col. 3; Col. 4, lines 1-65; Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38), (Examiner notes that Shaffer clearly teaches a message server with a universal register/lookup table/database and access control/user verification functionality, wherein an email address generally clearly and obviously reads upon an Internet address having a mailbox address identical to an email address); and

- recorded in a digital file format code field of the client device record, a digital file format code indicating that the client device represented by the client device record is capable of receiving the digital format of the digital file, (Col. 2, lines 30-67; Col. 3; Col. 4, lines 1-65; Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38), (Examiner notes that Shaffer clearly teaches an access capability determination as well as multimedia attachments which are well-known to be digital in format, (Col. 1, lines 16-23).

Thus, Claims 5, 12 & 19 are found to be unpatentable over considerable consideration of the teachings of Shaffer.

6. Regarding Claims 6, 13 & 20, Shaffer is relied upon for those teachings noted herein. Shaffer further discloses wherein determining in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway, further comprises finding a capability record having a connection address equal to the email address, (Col. 2, lines 30-67; Col. 3; Col. 4, lines 1-65; Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38). Thus, Claims 6, 13 & 20 are found to be unpatentable over considerable consideration of the teachings of Shaffer.

7. Regarding Claims 7, 14 & 21, Shaffer is relied upon for those teachings noted herein. Shaffer further discloses wherein forwarding the email further comprises forwarding the entire email, including the digital object, to an email client in another transcoding gateway in a client device, (Col. 2, lines 30-67; Col. 3; Col. 4, lines 1-65;

Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38). Thus, Claims 7, 14 & 21 are found to be unpatentable over considerable consideration of the teachings of Shaffer.

8. Claims 2, 3, 9, 10, 16 & 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of US Patent 6,092,114 to Shaffer in view of US Patent 5,339,361 to Schwalm.

9. Regarding Claims 2, 9 & 16, Shaffer is relied upon for those teachings noted herein. Though Shaffer discloses an email administration system inclusive of access control, (Shaffer – Col. 1, lines 58-62), Shaffer does not specifically disclose wherein the email display capability status request includes a sender identification identifying the sender, and the method further comprises determining, in dependence upon the sender identification, that the sender is authorized to send email to a connection address in the domain. Schwalm specifically teaches a sender verification functionality, (Schwalm – Abstract & Fig. 2), wherein it would have been obvious to incorporate a sender verification means into the Shaffer system for purposes of providing controlled access and transmission/receipt confirmation by authorized parties, (Schwalm – Col. 1, lines 14-52), within an email system which already requires user verification like that of Shaffer, and wherein it would have been obvious to augment the Shaffer controlled access means by implementing sender verification as well. Thus, Claims 2, 9 & 16 are found to be unpatentable over considerable consideration of the teachings of Shaffer and Schwalm.

10. Regarding Claims 3, 10 & 17, Shaffer and Schwalm are relied upon for those teachings noted herein. Schwalm further discloses wherein determining that the sender

is authorized to send email to a connection address in the domain further comprises sending in dependence upon the sender identification and in dependence upon the domain identification, at least one sender authorization record, (Col. 1, lines 14-67; Col. 2, lines 1-15; & Claims 1-23), wherein:

- the sender authorization record represents authorization for the sender to send email to a connection address in the domain, (Col. 1, lines 14-67; Col. 2, lines 1-15; & Claims 1-23);
- the sender authorization record comprises sender authorization attributes including a connection address in the domain, (Col. 1, lines 14-67; Col. 2, lines 1-15; & Claims 1-23), (Examiner notes that in light of Shaffer, the sender record obviously includes connection addresses of those domains where the sender is authorized to transmit data/email for purposes of transmission verification); and
- finding at least one email display capability record for the domain further comprises finding in dependence upon the domain identification and in dependence upon the connection address, at least one email display capability status record for the domain, (Schwalm - Col. 1, lines 14-67; Col. 2, lines 1-15; & Claims 1-23), (Shaffer - Col. 6, lines 6-67 & Col. 7, lines 1-38), (Examiner again notes that Shaffer discloses wherein if an attachment does not need conversion, it is transmitted to the client/target. Moreover, Shaffer teaches a checking, determining and converting process, wherein the client does not intervene with the same, and wherein

the client/target email display capability status attributes are determinative of the need for sender notification and/or conversion).

Thus, Claims 3, 10 & 17 are found to be unpatentable over considerable consideration of the teachings of Shaffer and Schwalm.

Response to Arguments

11. Applicant's arguments filed 6 January 2006, have been fully considered but they are not persuasive. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how reconsideration avoids such references or objections.

12. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an email display capability status specifically comprising display device availability, display device recent usage, display availability, power status or recent capability use; and a communication distinct from any email message designed to inform a sender of email display capability status during preparation of an email message) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Examiner additionally notes that in the

determining of access/display capabilities and in performing the requisite conversions, Shaffer clearly teaches a display capability status. Examiner further notes that email addresses are well-known to reside on domains. Moreover, Examiner implicitly admits nothing within the prior office action, as when Examiner's arguments are understood **in their entirety**, they clearly and distinctly show why Applicant's claim language, as written, is found to be unpatentable in view of the prior art.

13. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Examiner notes that proper motivation was disclosed within paragraph 9 of the prior office action, as noted herein above.

14. In response to applicant's argument that there is no reasonable expectation of success in the proposed modification of the prior art, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Here, Examiner

respectfully disagrees with Applicant noting that the combined teachings clearly and obviously render Applicant's claims, as written, unpatentable.

15. Regarding Applicant's argument that Shaffer teaches away from Applicant's claimed invention, as Shaffer has "no concern whatsoever for the actual status of any client device", (Amendment – p.14), Examiner respectfully disagrees noting that Shaffer specifically teaches consideration of client device capabilities in order to make a determination as to conversion requirements. As device capabilities clearly read upon device status, Examiner again finds Applicant's claim language, as written, to be unpatentable in view of the prior art.

16. In response to applicant's argument that Schwalm is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Examiner respectfully disagrees with Applicant noting that the combined.

17. Thus, as Examiner has completely addressed Applicant's amendment, and finding Applicant's arguments do not show how the amendments and reconsideration of the same avoids such references or objections, Examiner hereby rejects all claims in their entirety as noted herein above.

18. **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the

event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (571)-272-3916. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571)-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arrienne M. Lezak
Examiner
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